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In re application of
Daniel J. Lubera et al.
Application No. 09/813,592
Filed: March 21, 2001
For: RESILIENT CLIP FASTENER

**DECISION ON PETITION
TO VACATE FINAL
RESTRICTION REQUIREMENT**

This is a decision on the petition, filed March 9, 2006, under 37 CFR §1.181, seeking review of the decision of the primary examiner. Petitioner requests vacating the species restriction/election requirement made final on February 27, 2006.

The petition is **DENIED**.

A review of the file record reveals in an Office Action dated November 22, 2005, an election/restriction requirement was made between three species. The Petitioner elected species 1, with traverse, on December 5, 2005, and received an Office action on the merits of species 1 on February 27, 2006, which addressed Petitioner's arguments, and made the restriction/election requirement final and withdrew claims 122-162.

The Petitioner states that the Office has not set forth a proper requirement for restriction, in that it has not met the two criteria for a proper requirement for restriction between patentably distinct inventions (remarks, pg 2 of 4, lines 8-11). The argument is not on point because a species restriction is not a restriction between patentably distinct inventions, merely between species of the same invention. With regard to Petitioner's assertion that there is no serious burden on the Office, the Examiner has responded to the point in the final restriction requirement, that it is not the number of claims that currently exist in the application, but that the number of claims added throughout the prosecution of the application that have, and continue to, expand the scope of each species that demonstrate the burden to the Office.

Finally, the Petitioner argues that the current examiner must give full faith and credit to the prosecution of the previous examiner, therefore the current examiner cannot give a restriction requirement where the previous examiner did not (petition, page 3 of 4). This is not persuasive because Petitioner's citation of MPEP 704 is drawn to giving full faith and credit to a previous examiner's search and action, unless there is knowledge of other prior art—that a new search should not be conducted in the mere hope of finding something. This passage of the MPEP does not speak to restriction requirements, it speaks to use of the prior art. Further, the current examiner clearly was aware of art specifically requiring further search—which is what actually prompted the need for the restriction requirement. It is clear that the current examiner is not conducting a new search merely hoping to find something.

It is clear from the Office action dated February 27, 2006 that the Examiner fully considered and addressed the arguments submitted by the applicants. It is also determined the restriction/election requirement between species is appropriate according to the MPEP and rules of practice.

SUMMARY: The Petition to Vacate the Restriction Requirement and examine all the claims present is **DENIED**.

Questions regarding this decision should be directed to Judy Swann at (571) 272-7075.



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